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Paper No. 8
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Artful Enterprises, Inc.

Serial No. 76/011,777

Katrina A. Lyon for Artful Enterprises, Inc.

LaVerne T. Thompson, Trademark Examining Attorney, Law
Office 116, (Meryl Hershkowitz, Managing Attorney).

Before Hanak, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Artful Enterprises, Inc., (applicant) seeks to register in typed drawing form FINEART.COM for "providing visual art services, namely providing services related to the purchase and sale of fine visual art and the promotion of arts in a retail store." The application was filed on March 27, 2000 with a claimed first use date of December 1997.

The Examining Attorney has refused registration on three grounds. First, the Examining Attorney contends that applicant's amended recitation of services is indefinite.

Second, the Examining Attorney contends that applicant's services should be classified in Class 35 and not Class 42. Third, citing Section 2(e)(1) of the Trademark Act, the Examining Attorney contends that applicant's mark is merely descriptive of applicant's services.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Considering the first ground of refusal, we reverse. We find that applicant's amended identification of services (providing visual art services, namely providing services relating to the purchase and sale of visual fine art and the promotion of arts in the retail store) is clear. We note that in the first Office Action the Examining Attorney suggested that applicant clarify its services by inserting the words "on-line ordering services." Applicant has explained that it does not deal in the purchase and sale of fine visual art on-line, but rather deals in the purchase and sale of fine visual art in a retail store. Hence, instead of inserting the words suggested by the Examining Attorney (on-line ordering services) to its original recitation of services, applicant narrowed its original recitation of services by adding at the end of said

recitation the words "in a retail store." To be blunt, we do not understand the logic of the Examining Attorney to the effect that adding the words "on-line ordering services" to applicant's original recitation of services results in an acceptable recitation whereas adding the words "in a retail store" does not.

As for the Examining Attorney's contention that applicant's services should be properly classified in Class 35 and not in Class 42, this second ground of refusal is now moot. When the application was filed on March 27, 2000 Class 42 was the correct class. However, effective January 1, 2002 the Classification System was changed and "new" Class 35 is now the proper class for applicant's services. At page 5 of its brief, applicant stated it would be willing to have its services in Class 35. Accordingly, if this decision is reversed on appeal, applicant's application will be passed to publication in Class 35.

We turn next to a consideration of whether applicant's mark FINEART.COM is merely descriptive of "providing visual art services, namely providing services relating to the purchase and sale of fine visual art and the promotion of arts in a retail store." A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality

or characteristic of applicant's goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). In determining whether a mark is merely descriptive of the services for which registration is sought, two important propositions must be kept in mind. First, the mere descriptiveness of a mark is not determined in the abstract, but rather is determined in relation to the services for which registration is sought. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). This proposition is acknowledged by applicant at page 2 of its brief. Second, in order to be held merely descriptive, a mark need not immediately convey information about all of the significant qualities or characteristics of the services for which registration is sought. A term is merely descriptive if it immediately conveys information about "one of the qualities" of the services for which registration is sought. Gyualy, 3 USPQ2d at 1010.

In arguing that its mark is not merely descriptive of its services, applicant makes the following comments at pages 2 and 3 of its brief:

Appellant provides visual art services in a brick and mortar retail store. ... The on-line presence associated with appellant's mark is merely an advertisement for appellant's goods and services available in this brick and mortar store. In fact, no goods are sold on-line

... If a customer wishes to avail himself of appellant's services, however, they must either go to the brick and mortar retail store or inquire via telephone. ... In the appellant's FINEART.COM mark the ".COM" distinguishes the mark because it imparts to the "FINEART" portion of the mark a distinctive appearance, sound, connotation and commercial impression. The term ".COM" imparts a connotation and commercial impression to the mark as a whole of being a modern, contemporary entity.

In short, applicant makes no serious attempt to argue that the FINEART portion of its mark is not merely descriptive of its services. Obviously, applicant's services are specifically identified as including "the purchase and sale of fine visual art." In other words, the term "fine art" is the generic term for the type of goods which applicant deals in at its retail store. As Professor McCarthy notes, a term is "descriptive of retail sales services if it is the generic name of a product sold at the outlet." 2 J.McCarthy, McCarthy on Trademarks and Unfair Competition, Section 11:16 at page 11-22 (4th ed. 2001).

Applicant attempts to save its mark from falling into the merely descriptive category by arguing that "the term '.COM' imparts a connotation and commercial impression to the mark as a whole of being a modern, contemporary entity." (Applicant's brief page 3). Continuing, applicant makes the startling statement at page 4 of its brief that "the '.com' extension does not represent a top level domain

name." The Examining Attorney has made of record a plethora of evidence amply demonstrating that the term ".com" is indeed a top-level domain name. Moreover, Professor McCarthy aptly states that "a top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark]." 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 7:17.1 at pages 7-28.1 to 7-29 (4th ed. 2001).

As previously noted, applicant has conceded "the on-line presence [.COM] associated with appellant's mark is merely an advertisement for appellant's goods and services." (Applicant's brief page 2). Moreover, the very specimen of use submitted by applicant is a page from its web site where applicant's "mark" appears at the top and the following appears in the text: "New Artists Online ... If you haven't explored our web site recently, now is the time to surf again! Very recent additions include Guy Buffet, Robert Lyn Nelson ... Few artists have so fully mastered their craft ... Take advantage of the easy access to their newest work and let us know what you think."

While applicant's services involving the sale of fine art may take place in a retail store, nevertheless, applicant's mark FINEART.COM immediately informs consumers

that they can gain valuable information about the fine art available in applicant's retail store by simply going on the Internet. In other words, applicant's mark FINEART.COM clearly informs consumers that applicant's fine art retail store has a web site, and that said web site is indeed FINEART.COM. Accordingly, we find that applicant's mark FINEART.COM immediately conveys information about at least one significant quality or characteristic of applicant's services of "providing visual art services, namely providing services related to the purchase and sale of fine visual art and the promotion of arts in the retail store."

In any event, as previously noted, "a top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark]." McCarthy, Section 7:17.1 at pages 7-28.1 to 7.29. See also Brookfield Communications v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1558 (9th Cir. 1999)("The '.com' top-level domain [merely] signifies the site's commercial nature.") and In re Martin Container, Inc., __USPQ2d__(TTAB June 11, 2002)(Application Serial No. 75/553,426).

Decision: The refusal to register on the basis that applicant's recitation of services is indefinite is reversed. The refusal to register on the basis that

applicant's services are improperly classified is dismissed as moot. The refusal to register on the basis that applicant's mark is merely descriptive of applicant's services is affirmed.